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| 10/807,393 | 03/24/2004 | Tokunori Kato | 119249 | 3341 |

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| EXAMINER |
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| WORKU, NEGUSSIE |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
| | 10/807,393 | KATO, TOKUNORI |
| **Office Action Summary** | Examiner | Art Unit |
| | NEGUSSIE WORKU | 2625 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>18 June 2008</u>.
2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) <u>1-16</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-16</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some *  c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>03/21/06; 03/24/04</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1.      This is a replay to the response filed on June 18, 2008, in which, claims 1-16 are

pending. Applicant's response to the double patenting rejection mailed on March 18,

2008 has been respectfully considered. However, up on further review, examiner

believes that the claimed invention is broad enough to read on the cited reference as

set forth below.

### *Priority*

2.      Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).  Receipt is acknowledged of papers submitted under 35

U.S.C. 119(a)-(d), which papers have been placed of record in the file.


### *Information Disclosure Statement*

3.      The information disclosure statement (IDS) submitted on 03/21/06 and 03/24/04

has been reviewed.  The submission is in compliance with the provisions of 37

CFR 1.97.  Accordingly, the examiner is considering the information disclosure

statement.

### *Claim Rejections - 35 USC § 112*

4.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.      Claim 10 recite the limitation "the second mode processing portion".  There is

insufficient antecedent basis for this limitation in the claim, and therefore, the

dependency of claim 10 not on 9 rather on claim 8. In claim 1, lines 6, "a data

processing unit" there is also insufficient antecedent basis for the limitation in the claim.

### Claim Rejections - 35 USC § 102

6.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.      Claims 1-16 are rejected under 35 U.S.C. 102 (e) as being anticipated by

Koppich et al. (USP 2003/0200503).

        With regard to claim 1, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1) comprising: a storing unit having a storage area for

storing image data (a facsimile system 102, having storage area for storing image data]

col.2, lines 0024); a recognition setting unit that enables the terminal device to

recognize the storage area in the storing unit as an external storage device (col.4, lines

0038); and a data processing unit  (data generating unit  102 of fig 1, col.2, lines 0022)

that reads image data from the storage area in the storing unit when image data is

written to the storage area from the terminal device and executes a prescribed process

on the image data (102 of fig 1, comprises DMM 114 via DDM 112 to store and retrieve

from storage 11 of fig 1, col.3, lines 0024) .

With regard to claim 2, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the terminal device is provided with a

Plug and Play function for automatically recognizing a device connected to and in

communication with the terminal device, the recognition setting unit using the Plug and

Play function to enable the terminal device to recognize the storage area in the storing

unit as an external storage device (a document processing 102 having plug  and play

device, see col.2, lines 0017-0018).

With regard to claim 3, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the data processing unit (100 of fig 1)

comprises a monitoring portion that constantly monitors the storage area in the storing

unit to determine whether image data has been written to the storage area from the

terminal device (processing device 100 of fig 1, has an internal controller  suitably acting

as a fully functional server with a necessary hardware and software that ensure proper

operation including storing data to designated storage area, col.2, lines 0019-0020).

With regard to claim 4, Koppich '503' teaches a data processing device connected to and in communication with a terminal device, (a data processing device shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102, 104, 108 and 106] as shown in fig 1), further comprising a deleting unit that deletes image data from the storage area after the data processing unit has completed a predetermined process on the image data in the prescribed process (processing device 100 of fig 1, has an internal controller suitably acting as a fully functional server with a necessary hardware and software that ensure proper operation including storing data to designated storage area and prescribed process col.2, lines 0019-0020).

With regard to claim 5, Koppich '503' teaches a data processing device connected to and in communication with a terminal device, (a data processing device shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102, 104, 108 and 106] as shown in fig 1), wherein the prescribed process is image forming process, and the data processing device (100 of fig 1) further comprising an image forming unit (108 of fig 1) that forms an image on an image forming medium based on the image data (facsimile 108 of fig 1, is an image forming device); and wherein the data processing unit comprises a reading portion that reads image data from the storage area in the storing unit when image data is written to the storage area from the terminal device, and a control portion that controls the image forming unit to form an image based on the image data (processing device 100 of fig 1, has an internal

controller  suitably acting as a fully functional server with a necessary hardware and

software that ensure proper operation including storing data to designated storage area,

prescribed process and reading data from the storage area, see col.2, lines 0019-0020).


With regard to claim 6, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the prescribed process is a facsimile

transmission process, in which the image data is affixed with a destination data

indicative of a destination of the image data (multifunction device 108 of fig 1, having

facsimile, e-mail transmission function); and the data processing device (102 shown in

fig 1) further comprising a communicating unit (100 of fig 1) connected to an external

network, (communication unit 100, connected to eternal network) and a data

transmitting unit that transmits the image data to a specified destination through the

communicating unit (facsimile system 108 of fig 1, transmit  data to specific destination

via communication unit 100 of fig 1); wherein the data processing unit (processing unit

102 of fig 1) comprises a reading portion that reads image data from the storage area in

the storing unit and reads the destination data from the storage area when the image

data is written to the storage area from the terminal device, and a control portion that

controls the data transmitting unit to transmit the image data to the destination based on

the destination data (processing device 100 of fig 1, has an internal controller  suitably

acting as a fully functional server with a necessary hardware and software that ensure

proper operation including storing data to designated storage area, prescribed process

and reading data from the storage area, see col.2, lines 0019-0020).


With regard to claim 7, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the communicating unit (100 of fig 1) is

capable of communicating with an external facsimile machine via the network, (facsimile

device 108 communicating with external facsimile machine via communication unit 100,

which is a network) the control portion controlling the data transmitting unit to transmit

the image data as facsimile data to the external facsimile machine at the destination

based on the destination data, see col.2, lines 0019-0020).


With regard to claim 8, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the storing unit is capable of storing

image data and classification data representing a classification of the image data

(storage area 110 of fig 1); and wherein the data processing unit (processing device

shown in fig 1) comprises: a first mode processing portion providing a first prescribed

process (scanning can be first processing); a second mode processing portion providing

a second prescribed process (printing can be the second prescribed processing); and a

selection portion selecting one of the first prescribed process and the second prescribed

process based on the classification data for the image data that is written together with

the image data in the storing unit at the time the image data is written to the storage

area from the terminal device for executing a selected one of the first prescribed

process and the second prescribed process (image data is written to the storage area

from the terminal device for executing a selected one of the first prescribed, see col.1,

lines 0010-0012).

With regard to claim 9, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), further comprising an image forming unit (108 of

fig 1) that forms an image on an image forming medium based on the image data

(image forming unit 108, forming image based on the image data); and wherein the first

mode processing portion comprises a reading section that reads the image data from

the storage area of the storing unit; and a control section that controls the image

forming unit to form images based on the image data, (processing device 100 of fig 1,

has an internal controller  suitably acting as a fully functional server with a necessary

hardware and software that ensure proper operation including storing data to

designated storage area, prescribed process and reading data from the storage area,

see col.2, lines 0019-0020).

With regard to claim 10, Koppich '503' teaches a data processing device
connected to and in communication with a terminal device, (a data processing device
shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,
104, 108 and 106] as shown in fig 1) further comprising: a communicating unit
connected to an external network (100 of fig 1, connected to the network); and a data
transmitting  (facsimile 108 of fig 1) that transmits the image data to a specified
destination via the communicating unit (communicating unit 100 of fig 1); and wherein
the image data is attached with a destination data representing a destination for the
image data, the destination data being also stored in the storage area (storage area 110
of fig 1, stores destination data addresses); and wherein the second mode processing
portion comprises a reading section that reads image data from the storage area of the
storing unit and reads the destination data from the storage area (computer 102 of fig 1,
comprises reading portion); and a control section that controls the data transmitting unit
to transmit the image data to the destination based on the destination data, (processing
device 100 of fig 1, has an internal controller  suitably acting as a fully functional server
with a necessary hardware and software that ensure proper operation including storing
data to designated storage area, prescribed process and reading data from the storage
area, see col.2, lines 0019-0020).


With regard to claim 11, Koppich '503' teaches a data processing device
connected to and in communication with a terminal device, (a data processing device
shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the image data is also attached with a

transmission time data representing the transmission time for the image data,

(transmission time such as sending and receiving time is inherent in any communication

method) the transmission time data being also stored in the storage area (the

transmitted data is stored in a storage device before user printed out); and wherein the

reading section also reads transmission time data (computer 104, readout data from the

storage area including timing); and wherein the control section controls the data

transmitting unit to transmit the image data to a destination based on the destination

data at a time represented by the transmission time data, (processing device 100 of fig

1, has an internal controller  suitably acting as a fully functional server with a necessary

hardware and software that ensure proper operation including storing data to

designated storage area, prescribed process and reading data from the storage area,

see col.2, lines 0019-0020).


     With regard to claim 12, Koppich '503' teaches a data processing device

connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), wherein the communicating unit (100 of fig 1) is

capable of communicating with an external facsimile machine (108 of fig 1) via the

network (communication unit 100 is connected to the network); and wherein the control

section controls the data transmitting unit to transmit the image data as facsimile data to

the external facsimile machine at the destination based on the destination data,

(processing device 100 of fig 1, has an internal controller suitably acting as a fully functional server with a necessary hardware and software that ensure proper operation including storing data to designated storage area, prescribed process and reading data from the storage area, see col.2, lines 0019-0020).

With regard to claim 13, Koppich '503' teaches a data processing device connected to and in communication with a terminal device, (a data processing device shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102, 104, 108 and 106] as shown in fig 1), wherein the data processing unit further comprises a third mode processing portion providing a third prescribed process, the selection portion selecting one of the first prescribed process, the second prescribed process and the third prescribed process based on the classification data for the image data that is written together with the image data in the storing unit at the time the image data is written to the storage area from the terminal device for executing a selected one of the first prescribed process, the second prescribed process and the third prescribed process, (processing device 100 of fig 1, has an internal controller suitably acting as a fully functional server with a necessary hardware and software that ensure proper operation including storing data to designated storage area, plurality of prescribed process from the storage area, see col.2, lines 0019-0020).

With regard to claim 14, Koppich '503' teaches a data processing device connected to and in communication with a terminal device, (a data processing device

shown in fig 1, comprises a communication unit 100 with a terminal devices (i.e., 102,

104, 108 and 106] as shown in fig 1), further comprising a communicating unit (100 of

fig 1) connected to an external network (communication unit 100 of fig 1, connected to

the external network); and a mail transmitting unit that transmits image data in an e-mail

format to a specified destination (server 104 of fig 1, e-mail via communication unit

100); and wherein the image data is attached with a destination data representing a

destination for the image data, the destination data being also stored in the storage area

(facsimile device 108, has a address destination storage area); and wherein the third

mode processing portion (which is shown in fig 1) comprises: a reading section that

reads image data from the storage area in the storing unit and reads destination data

from the storage area, and a control section that controls the mail transmitting unit to

transmit the image data in the e-mail format to a destination based on the destination

data, (processing device 100 of fig 1, has an internal controller  suitably acting as a fully

functional server with a necessary hardware and software that ensure proper operation

including storing data to designated storage area, prescribed process and reading data

from the storage area, see col.2, lines 0019-0020).


With regard to claim 15, Koppich '503' teaches a facsimile machine connected to

and in communication with a terminal device, (108 shown in fig 1, comprises a

communication unit 100 with a terminal devices (i.e., 102, 104, 108 and 106] as shown

in fig 1), comprising: a communicating unit (100 of fig 1, is a communicating unit)

connected to an external network and capable of transmitting and receiving facsimile

data (communicating unit 100, connected to the external unit via network); and a data

processing device connected to and in communication with a terminal device through

the external network, (processing device shown in fig 1), comprising: a storing unit (110

of fig 1) having a storage area for storing the facsimile data (storage 110 of fig 1, stores

facsimile data); a recognition setting unit that enables the terminal device to recognize

the storage area in the storing unit as an external storage device (col.4, lines 0038); and

a data processing unit that reads the facsimile data from the storage area in the storing

unit when the facsimile data is written to the storage area from the terminal device and

executes a prescribed process on the facsimile data (processing device shown in fig 1,

has an internal controller  suitably acting as a fully functional server with a necessary

hardware and software that ensure proper operation including storing data to

designated storage area, prescribed process and reading data from the storage area,

see col.2, lines 0019-0020).


With regard to claim 16, Koppich '503' teaches a storage medium that stores a

program for permitting a facsimile machine to function as a data processing device data

processing device connected to and in communication with a terminal device, (a data

processing device shown in fig 1, comprises a storage device 110, a communication

unit 100 with a terminal devices (i.e., 102, 104, 108 and 106] as shown in fig 1), through

a network, and a storage unit including a storage area that stores therein image data

(storage 110 of fig 1), the program comprising: a program of enabling the terminal

device to recognize the storage area in the storing unit as an external storage device

(program run in computer 104, enabling the terminal device to recognize storage area,

that includes reading out image data and execute prescribed process); and a program

of reading image data from the storage area in the storing unit when image data is

written to the storage area from the terminal device and executing a prescribed process

on the image data, (processing device of fig 1, has an internal controller  suitably acting

as a fully functional server with a necessary hardware and software that ensure proper

operation including storing program that designated storage area, prescribed process

and reading data from the storage area, see col.2, lines 0019-0020).


### *Conclusion*

8.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to NEGUSSIE WORKU whose telephone number is

(571)272-7472.  The examiner can normally be reached on 9A-6PM.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward Coles can be reached on 571-272-7402.  The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/Negussie Worku/

Examiner, Art Unit 2625